INDEX

CITATIONS

	Page
Cases:	
Dalzell v. *Dueber Watch Case Mfg. Co.*, 149 U. S. 315	2
Hapwood v. *Hewitt*, 119 U. S. 226	2
Pressed Steel Car Co. v. *Hansen*, 137 Fed. 403	3
Statute:	
Act of March 3, 1883, c. 143, 22 Stat. 625, as amended by the Act of April 30, 1928, c. 460, 45 Stat. 467	3

141191—32

In the Supreme Court of the United States

OCTOBER TERM, 1932

No. 316

THE UNITED STATES OF AMERICA, PETITIONER

v.

DUBILIER CONDENSER CORPORATION

No. 317

THE UNITED STATES OF AMERICA, PETITIONER

v.

DUBILIER CONDENSER CORPORATION

No. 318

THE UNITED STATES OF AMERICA, PETITIONER

v.

DUBILIER CONDENSER CORPORATION

ON PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT

REPLY BRIEF FOR THE PETITIONER

The respondent questions the statement made in the petition that this case presents a question of

law of first impression in this Court, and cites *Hapgood* v. *Hewitt,* 119 U. S. 226, a case not cited in the petition, as a prior decision of this Court which is controlling in the instant cases. But the point involved in the cases at bar was not presented in the *Hapgood* case. There the Court held that the employee was not required, either expressly or by implication, to exercise his inventive faculties for the benefit of his employer; in other words, that inventive work was no part of his duties. The Court said (p. 233):

> The decision of the Circuit Court, 11 Bissell, 184, was placed on the ground (1) that Hewitt was not expressly required, by his contract, to exercise his inventive faculties for the benefit of his employer, and there was nothing in the bill from which it could be fairly inferred that he was required or expected to do so; * * *
>
> We are of opinion that the views taken of the case by the Circuit Court were correct.

Clearly, in the case cited the Court can not be deemed to have passed upon the rights of an employer to the inventions of an employee whose duties included the doing of inventive work.

The respondent also cites *Dalzell* v. *Dueber Watch Case Mfg. Co.,* 149 U. S. 315. There, too, the employee's duties did not include inventive work, Dalzell having been employed as a skilled mechanic. It was claimed by the employer, and denied by Dalzell, that subsequently to the original

contract of hiring a supplemental contract was entered into by which the latter became obligated to convey his inventions to his employer. The Court found that the existence of such a contract was not proved.

The other decisions of this Court to which the respondent refers are considered in the petition.

The respondent also cites several decisions of the lower Federal courts which, it is claimed, sustain the decision in the instant cases. We submit that none of the cases cited decide the question here involved, with the possible exception of *Pressed Steel Car Co.* v. *Hansen,* 137 Fed. 403 (C. C. A. 3d), where we believe that the better reasoning is in the dissenting opinion.

We submit further that counsel for the respondent are in error in stating (Br. p. 17) that the policy of the Government with respect to patents upon inventions of its employees is expressed in the Act of March 3, 1883, c. 143, 22 Stat. 625, as amended by the Act of April 30, 1928, c. 460, 45 Stat. 467. That statute provides that a Government official or employee may prosecute an application for a patent in certain instances without the payment of the usual Patent Office fees, if he grants a license to the Government. The statute is in the broadest of terms and contains no limitations with respect to the character of the work of the employee or as to the time during which the invention is perfected, i. e., during the regular hours of work or on

the employee's own time. We believe that the statute was intended to apply to those cases, numerous in number, where inventions are made by Government employees who are not engaged in work of inventive character and where the inventions do not arise out of or in connection with the employee's duties, and that the purpose of the statute was to aid such persons in obtaining patents if they were willing to grant to the United States a license to which it would not otherwise be entitled. See 32 Ops. A. G. 145, 149.

Respectfully submitted.

THOMAS D. THACHER,
Solicitor General.

CHARLES B. RUGG,
Assistant Attorney General.

ALEXANDER HOLTZOFF,
Special Assistant to the Attorney General.

PAUL D. MILLER,
Attorney.

SEPTEMBER, 1932.

U. S. GOVERNMENT PRINTING OFFICE: 1932